

REMARKS

Claims 1-29 are pending. Applicant is in receipt of the Office Action dated March 24, 2003. In the Office Action, claim 4 was objected to because of an informality; claims 1-4, 6-19, 24-26, and 29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Choi et al. (U.S. Patent No. 5,586,333, hereinafter referred to as "Choi") in view of Ogawa et al. (U.S. Patent No. 4,716,543, hereinafter referred to as "Ogawa"); and claims 5, 20-23, and 27-28 were rejected under 35 U.S.C. §103(a) as being unpatentable over Choi and Ogawa as applied to claims 1-4, 6-19, 24-26, and 29, and further in view of Suboh (U.S. Patent No. 5,619,707).

Applicant respectfully submits that the present application is allowable in view of the above amendments and the following remarks.

Claim Objections

Claim 4 was objected to because there was a typographical error in the dependency of claim 4. Applicant has amended claim 4 to correct this error.

§103 Rejections

Applicant respectfully traverses the §103(a) rejection of claims 1-4, 6-19, 24-26, and 29 as being unpatentable over Choi in view of Ogawa.

Claim 1 of the present application recites as follows:

1. A method for managing power consumed by a computer system, comprising directing access intended for a device coupled to said computer system to an alternate memory space in said computer system when said device is powered off during power management state of said computer system.

The Choi patent generally relates to power management of the computer system. However, the Office Action admits that "Choi et al. does not teach directing access intended for a peripheral device to an alternate memory space when the peripheral device is powered off." The Office Action relies on the Ogawa reference as teaching this missing limitation of Choi. The Ogawa patent relates to a terminal device for preparing a

document and communicating data. The Ogawa patent teaches at column 2 beginning at line 57 "When printing operation is disabled due to a failure in a printer of the output section or the like after the received document data has been loaded in a memory of the communication control, the document data is immediately delivered to the external storage to open the document data storage area."

Applicant first notes that, even if these references were properly combinable, which Applicant submits they are not, that a combination of these references does not teach claim 1 of the present application. Claim 1 recites "directing access ... to an alternate memory space in said computer system when said device is powered off during power management state of said computer system." At most, Ogawa teaches delivering document data to an external storage, not an alternate memory space in the computer system. Also, delivery of data to an alternate storage occurs when a printing operation is disabled due to a failure in a printer, not during a power management state of the computer system.

Further, Applicant respectfully submits that the Choi et al. and Ogawa references are not properly combinable as suggested in the Office Action. The Choi et al. patent relates to power management of a computer system. In contrast, the Ogawa et al. patent is directed toward a terminal device for preparing documents. The Ogawa patent is not at all related to power management of a computer system or for enabling proper operation of a computer system when a device has been powered off by power management software within a computer system. Applicant respectfully submits that the present combination of references amounts to a hindsight reconstruction of the present claims.

The suggestion that these references are combinable to teach the present claims appears to be based solely on hindsight, not on any teachings of the prior art. "To imbue one of ordinary skill in the art with knowledge of the invention... when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed.Cir.1983). "To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a

convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references... [S]implicity and hindsight are not the proper criteria for resolving the issue of obviousness.” *Ex Parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int’f 1985).

Applicant submits that claim 1 and those dependent thereon are allowable over the cited references. Applicant further submits that claims 1, 7, 17, 20, 24, 25, 27 and 29 are allowable for at least the reasons given above with respect to claim 1.

Thus, Applicant respectfully submits that the present claims are in condition for allowance.

CONCLUSION

Applicants submit the application is in condition for allowance, and an early notice to that effect is requested.

If any extensions of time (under 37 C.F.R. § 1.136) are necessary to prevent the above referenced application(s) from becoming abandoned, Applicant(s) hereby petition for such extensions. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 50-1505/ 5681-71400 /JCH.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
☐ Other: *Address Change*

Respectfully submitted,



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